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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,778	08/11/2000	David M. Goldschlag	2685/5681	1089

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EXAMINER
YOUNG, JOHN L

ART UNIT	PAPER NUMBER
3622	#2

DATE MAILED: 05/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

09/635,778

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Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/635,778	Goldschlag et al.
Examiner	**Art Unit**
John Young	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Aug 11, 2000* .

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-27* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☒ The proposed drawing correction filed on *Aug 11, 2000* is: a) ☒ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Drawings

1. This application has been filed with drawings that are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM OBJECTIONS—37CFR 1.75

37 CFR 1.75(a) requires:

> "[claims] particularly pointing out and distinctly claiming the subject matter which the applicant regards as his/her invention or discovery. . . ."

2. Claim 13 is objected to pursuant to 37 CFR 1.75(a); there appears to be a minor typographical error in claim 13:

In claim 13, at line 5, after the word "receive" delete the word "an" and replace it with the word --a--.

NONSTATUTORY DOUBLE PATENTING

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 8-13, 15, 17, 19 & 21-27 of U.S. Patent No. 6, 108,644 Goldschlag et al. SYSTEM AND METHOD FOR ELECTRONIC TRANSACTIONS (Aug. 22, 2000) [US f/d: Feb. 19, 1998] (herein referred to as "Goldschlag 6,108,644"). Although the conflicting claims are narrower and therefore are not identical, they are not patentably distinct from each other, i.e., claims 1-27 of the instant application if allowed, would improperly extend the right to exclude already granted in U.S. Patent to Goldschlag 6,108,644.

As per claims 1-5, 8-13, 15, 17, 19 & 21-27, the subject matter claimed in the instant application is fully disclosed in U.S. Patent to Goldschlag 6,108,644 (for example,

see Goldschlag 6,108,644 (col. 10, ll. 48-67)), i.e., the patent and the application are claiming common subject matter, as follows: (1) In the Goldschlag 6,108,644 patent, claims 1-5, 8-13, 15, 17, 19 & 21-27 substantially recite a broad system and method for conducting electronic transactions over a communications network. (2) In the instant application of Goldschlag, claims 1-5, 8-13, 15, 17, 19 & 21-27 substantially recite a narrow system and method for conducting an electronic voting transaction over a communications network. Therefore, the differences between the Goldschlag 6,108,644 patent and the instant application of Goldschlag reside in the breadth of claim language of each; and the electronic voting transaction claim language of the instant Goldschlag application is albeit narrower however none-the-less an obvious variation of the broad electronic transactions of the Goldschlag 6,108,644 patent. It would have been obvious to a person of ordinary skill in the art at the time of the invention that the "electronic transaction" claims language of the instant application would have been selected in accordance with a system and method for conducting electronic transactions over a communications network because such selection would have provided means for *"a reliable, private system for electronic transactions that deters the illicit sharing of certificates for such transactions. . . ."* (see Goldschlag 6,108,644 (col. 4, ll. 16-25)) and because *"[in] this embodiment, a voter registers and receives a validated, blinded certificate to cast in a vote. The registration process ensures, for example, that each voter is entitled to cast only one vote. . . ."* (See Goldschlag 6,108,644(col. 10, ll. 49-54)). Furthermore, there is no apparent reason why Applicant was prevented from

presenting claims corresponding to claims 1-5, 8-13, 15, 17, 19 & 21-27 of the instant application (during prosecution of the application which matured into a patent. See MPEP § 804.

As per claims 6, 7, 14, 16, 18 & 20, the subject matter claimed in the instant application is impliedly disclosed in U.S. Patent to Goldschlag 6,108,644, i.e., the patent and the application are claiming common subject matter, as follows: (1) In the Goldschlag 6,108,644 patent, claims 6, 7, 14, 16, 18 & 20 substantially recite a broad system and method for conducting electronic transactions over a communications network comprising a product and a port. (2) In the instant application of Goldschlag, claims 6, 7, 14, 16, 18 & 20, substantially recite a narrow system and method for conducting electronic voting transactions over a communications network "wherein the certificate indicates a yes or not vote. . . ." [as per claims 6, 14 & 18] and "wherein the parity of the certificate indicates a yes or a no vote. . . ." [as per claims 7, 16 & 20]. In this case the Examiner interprets the yes/no vote certificate and parity distinction as being equivalent to a product communicated via a port in the communications network. It would have been obvious to a person of ordinary skill in the art at the time of the invention that "wherein the certificate indicates a yes or not vote. . . ." and "wherein the parity of the certificate indicates a yes or a not vote. . . ." would have been selected in accordance with a system and method for conducting electronic transactions over a communications network comprising a product and a port because such selection would

have provided means for *"a reliable, private system for electronic transactions that deters the illicit sharing of certificates for such transactions. . . ."* (see Goldschlag 6,108,644 (col. 4, ll. 16-25)) and because *"[in] this embodiment, a voter registers and receives a validated, blinded certificate to cast in a vote. The registration process ensures, for example, that each voter is entitled to cast only one vote. . . ."* (See Goldschlag 6,108,644(col. 10, ll. 49-54)). Therefore, the differences between the Goldschlag 6,108,644 patent and the instant application of Goldschlag reside in the breadth of claim language of each; and the electronic voting transaction claim language of the instant Goldschlag application is albeit narrower however none-the-less an obvious variation of the electronic transaction of the Goldschlag 6,108,644 patent. Furthermore, there is no apparent reason why Applicant was prevented from presenting claims corresponding to claims 6, 7, 14, 16, 18 & 20 of the instant application during prosecution of the application which matured into a patent. See MPEP § 804.

JOINT INVENTORS, COMMON OWNERSHIP PRESUMED

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

RELEVANT PRIOR ART

5. The prior art references made of record and not relied upon are considered pertinent to Applicant's disclosure:

US 6,250,548 (Jun. 26, 2001) McClure et al., 235/51
"ELECTRONIC VOTING SYSTEM." This reference discusses an "electronic ballot" (see col. 4, ll. 21-45) ref. Claims 6, 7, 14, 16, 18 & 20.

US 6,092,051 (Jul. 18, 2000) Kilian et al., 705/12
"SECURE RECEIPT-FREE ELECTRONIC VOTING." This reference discusses "(yes/no)" elecronic voting. (See col. 1, ll. 5-55) ref. Claims 1-27.

US 5,495,532 (Feb. 27, 1996) Kilian et al., 380/30
"SECURE ELECTRONIC VOTING USING PARTIALLY COMPATIBLE HOMOMORPHISMS." This reference discusses elecronic voting. (See the ABSTRACT; col. 2, ll. 39-55) ref. Claims 1-27.

CONCLUSION

6. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or

(703) 746-7239 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Sixth floor Receptionist
Crystal Park II
2121 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

John L. Young
Patent Examiner

May 20, 2002